

REMARKS

The last Official Action has been carefully considered. Claims 77, 78, 80-86, 88, 90, 93 108, 109 and 113 remain in the case. Claims 79, 87, 89, 91, 92, 94-107, 110-112, and 114-117 have been cancelled without prejudice, applicant, at this stage, not having decided whether continuations, continuations-in-part or divisional applications will be filed for at least some of those claims.

Applicant has asked the undersigned attorney to thank the Supervisory Patent Examiner, James Housel, Esq. and the Examiner, Dr. Ulrike Winkler for the telephone interview kindly granted to applicants' representatives on October 17, 2003. The Examiner will recall that the case was discussed at length in the light of the Prusiner patent reference as contrasted to the Williamson's publication which applicants drew to the Examiner's attention some time ago. The Williamson's publication, of which Dr. Prusiner is a co-author, was published in the *Journal of Virology*, 1998.

As a result of the interview, the Patent Office issued an Interview Summary which was sent to the undersigned attorney on October 21, 2003 and which contains as the last page a number of requirements, the gist of which is that a person knowledgeable in the prion technology before and after the Prusiner patent reference persuasively declare and provide evidence in respect to the two points (1) and (2) appearing on the last page of the Interview Summary. Accordingly, applicants submit herewith the Declaration pursuant to 37 CFR § 132 of Professor Glen Christopher Telling who is a Professor at the University of

Kentucky. His impressive *curriculum vitae* attached to the Declaration indicates that Professor Telling was a member of the Prusiner research group and in fact is co-inventor of a number of patents with Dr. Prusiner. Professor Telling also states that he is fully familiar with the Williamson, et al. publication, the Prusiner reference patent and the above application. The Declaration was submitted informally to Examiner Winkler and she indicated over the telephone that it was persuasive and that the claims would be allowable, particularly in view of paragraph 16 of the Declaration which *expressis verbis* states that the Prusiner method as described in its Patent No. 5,846,533 leads to conventional antibodies but "is not suitable for producing antibodies specifically binding to native PrP^{Sc} without binding to native PrP^C, this statement being based on the explanations given by Professor Telling in the preceding paragraphs.

The Examiner also indicated that the passage, namely that pursuant to the present invention, antibodies are produced which specifically bind to native PrP^{Sc} without binding to native PrP^C should be included in each of the claims. This has been done, it being noted that claim 77, submitted with the last amendment already contained this language. "A monoclonal antibody or a fragment thereof capable of binding only to native diseased specific prion protein (PrP^{Sc}) and not to native normal prion protein (PrP^C)."

In discussing the Declaration, the Examiner also stated that each of the claims should recite that the antibody is "isolated." To satisfy the Examiner, each of the relevant claims now does recite that the antibody in question is isolated. However, as was pointed out

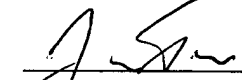
to the Examiner, the term "isolated" should not be construed in an absolute sense but as is common in this art, covers any isolated fractions, including the antibodies, i.e., the antibody itself but also supernatants of antibody producing cells containing the antibody. Applicant has reluctantly inserted the term "isolated" with the understanding that it is to be construed in the above sense.

It is believed that this amendment places the case in condition for allowance and such action is respectfully solicited. If the Examiner has any further questions, she is respectfully requested to call the undersigned at 212-839-7355 to resolved any possible outstanding issues.

Again, applicants would like to thank the Examiner and her supervisor for the cooperative attitude displayed during the two telephone interviews that have taken place.

If any fee is required with this amendment, the Commissioner is authorized to charge our Deposit Account No. 50-0955. A petition for a two-month extension of time is enclosed herewith.

Respectfully submitted.



David Toren
Reg. No. 19,468

Dated: December 30, 2003
Sidley Austin Brown & Wood LLP
787 Seventh Avenue
New York, NY 10019
Tel.: (212) 839-7355

I hereby certify that this correspondence is being forwarded via Federal Express, addressed to: U.S. Patent and Trademark Office, 2011 South Clark Place, Customer Window, Crystal Plaza Two, Lobby, Room 1B03, Arlington, VA 22202 on December 30, 2003.

